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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,020	07/23/2003	Kevin L. Parsons	89199	8420

24628 7590 04/10/2007  
WELSH & KATZ, LTD  
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CHICAGO, IL 60606

EXAMINER
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PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/625,020

Applicant(s)

PARSONS, KEVIN L.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 55-73 and 75-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-73 and 75-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are the actuator button. The specification does not disclose where the apparatus can function without the actuator button cooperating against the actuator.

MPEP 2172.01 sets forth that, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965). Here the the specification only sets forth a movable cap in combination with an actuator button (78). Nothing in the specification supports the working combination of just a movable cap with an actuator for movement in an axial direction. At [0057] of the specification it only sets forth "depression of the actuator button 78 when the safety slide button 80 is in a position enabling depression causes the plunger actuator 72 to move..." There is no disclosure that his invention is workable absent the actuator button. Absent the combination of the actuator button as an essential element, there is no way the depressing the cap can cause the actuator to move. Hence the scope of the claim is unclear. One could argue based on applicant's position that the actuator button is implicitly recited because the actuator would not move without it or that anything that

causes the actuator to move upon pressing the button would be within the scope of the claim. Obviously, permitting such argument is not permissible and the scope of the claim must be rendered definite.

***Claim Rejections - 35 USC § 103***

Claims 75-79 and 81-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLucia 3,776,429 in view of Parsons 6,283,609.

As to claims 75-79, 83, 84, 85, DeLucia shows a dispenser 32 to receive a cartridge 44 having an orifice 62 in a forward portion. He further shows an actuator 130, button 122 and end 16 capable of connection between an end cap. DeLucia does not discuss the connection of his device with a baton. Parsons '609 teaches combining apparatus such as that of DeLucia with a baton in order to be able to additionally use it to strike a person. To have combined a baton capable of attaching at end 16 would have been obvious as taught by Parsons in order to make it a more effective striking weapon. As to claims 81 and 82, DeLucia shows a nozzle plate 17 that is inherently interchangeable with a replacement for repair meeting the limitations of the claim. As to claims 75, 86 and 87, element 46 is considered to be an insertable sleeve. As to claim 88, making sleeve 34 of foam is considered to be an obvious matter of choice in materials. Applicant has not shown were such a material is critical to the claimed invention by solving any particular problem or producing any unexpected results. As to claim 89, the discharge orifice is considered to be axial aligned to the nozzle of the

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cartridge via tube 64. As to claim 90, the tubular body at 46 coupled to the coupling connector 34.

With respect to applicant's remarks to claim 86, the interpretation of DeLucia as been clarified as element 46 being a slidable sleeve. Contrary to applicant's position, 46 is considered to meet the limitations of "slidably insertable sleeve" in that the "capsule 44 which is longitudinally slidable within a sleeve 46" (col. 2, ln. 41) as disclosed. Whether or not DeLucia discloses that his sleeve 46 is movable or can operate without is immaterial since such features are not set forth in the claims.

As to claim 78, 138 is considered to be a guide and 128 a spring about the guide pin.

As to claims 81 and 91, it recites a nozzle plate which is shown by 71 of DeLucia. The nozzle plate being interchangeable is considered functional and does not distinguish over the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The claim does not clearly recite that the plurality of nozzle plate are positively part of the claimed combination. It is apparent that they are part of the functional recitations of the claim. Even if positively recited, interchangeable lens plates are known to flashlights like DeLucia.

As to claim 84, element 24 is considered to be a removable retainer supporting the nozzle plate 25 and defining the discharge orifice 66. Sealing removable retainers

as called for in claim 85 is considered old and well known as are grip enhancing surfaces such as knurled surfaces as called for in claim 88..

### ***Conclusion***

As to claim 55-74 and 80, DeLucia shows a dispenser 32 to receive a cartridge 44 having an orifice 62 in a forward portion. He further shows an actuator 130 and a cap of elements that could be considered elements 96 and 122 combined. However, both elements are not capable of moving from a first and second positions and being depressed radially. Likewise the actuator mechanism of Chen is similar, however the cap 58 does not move from a first to a second position. Pierpoint shows an electronic button. In Cellini, button 40 must be depressed before actuator button 34 can be slide forward. Examiner could not find the claimed safety button in the broad prior art of actuator buttons, switches or triggers.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**